

REMARKS

This is a full and timely response to the non-final Official Action mailed January 16, 2003 (Paper No. 2). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, the specification and claims 1, 4, 8 and 16 have been amended. Additionally, new claims 20-31 have been added. No original claims have been cancelled. Thus, claims 1-31 are currently pending for the Examiner's consideration.

In the outstanding Office Action, the Examiner objected to claim 19 due a misstatement of the claim's dependency. This problem has been corrected by the present amendment. Following entry of this amendment, all the remaining claims are believed to be unobjectionable in compliance with 35 U.S.C. § 112. Notice to that effect is respectfully requested.

With regard to the prior art, the recent Office Action rejected claims 1, 4 and 7 as being anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,761,061 to Amano ("Amano"); claims 2-3, 8-12 and 15-19 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Amano and U.S. Patent No. 6,282,407 to Vega et al. ("Vega"); and claims 5, 6, 13 and 14 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Amano and U.S. Patent No. 6,060,789 to Yamaguchi ("Yamaguchi"). For at least the following reasons, these rejections are respectfully traversed.

Claim 1 has been amended herein to include the subject matter of original claim 4. Claim 1, as amended, recites:

1. (currently amended) A smart card comprising:
processing and memory circuitry;
an interface for electrically connecting said smart card to a host device, said interface comprising a power line for receiving power from said host device;
a primary battery disposed in said smart card for providing power to said processing and memory circuitry; and
a secondary rechargeable battery disposed in said smart card for providing power to said processing and memory circuitry; and
recharging circuitry for recharging said secondary battery with power from said host device.

Applicant wishes to emphasize the recitation of recharging circuitry that recharges the “secondary battery *with power from the host device.*” (emphasis added).

In contrast, Amano fails to teach or suggest any battery in a smart card that is recharged with power received from a host device in which the smart card is or can be installed. In fact, Amano expressly teaches away from the invention in this regard.

According to Amano, “[t]he second diode 22 is placed to prevent the main battery 18 from being charged.” (Col. 4, lines 37-39). Thus, the main battery (18) is never charged at all. When the main battery (18) is depleted, it is replaced. (See, Col. 5, line 36 *et seq.*). Thus, the main battery is clearly not charged with power from a host device.

The auxiliary battery (20) taught by Amano is also never charged with power from a host device. “The second diode 22 is provided in a line 26 running from the voltage supply line 10 to the junction 28 of the main battery 18 and the auxiliary battery 20. Since the second diode 22 is

placed in a forward direction running from the junction 28 toward the voltage supply line 10, *the auxiliary battery 20 is charged only from the main battery 18, thereby preventing a charging current from flowing into the auxiliary battery 20 from the external [power supply] 8.*" (Col. 4, lines 23-31) (emphasis added).

Consequently, Amano fails to teach or suggest the claimed "recharging circuitry for recharging said secondary battery with power from said host device." "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, Amano cannot anticipate claims 1, 4 and 7. Thus, the rejection of claims 1, 4 and 7 made in reliance on the teachings of Amano should be reconsidered and withdrawn.

Claims 2-3, 8-12 and 15-19 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Amano and Vega. This rejection is traversed for essentially the same reasons given above with regard to the rejection of claim 1.

Claims 2 and 3 depend from claim 1. As demonstrated above, Amano fails to teach or suggest the "recharging circuitry" of claim 1. Vega likewise fails to teach or suggest such recharging circuitry where two batteries are provided in a smart card and at least one is charged

with power drawn from a host device. Appropriately, the recent Office Action does not allege that Vega contains any such teaching.

Claims 8 and 16 recite subject matter similar to that of claim 1. Claims 8 and 16 recite:

8. (currently amended) A method of providing power to processing and memory circuitry of a smart card said method comprising:

 providing power to said processing and memory circuitry with a primary non-rechargeable battery disposed in said smart card; and

 providing a secondary rechargeable battery disposed in said smart card that is charged when said smart card is installed in a host device; and

charging said secondary rechargeable battery with power from said host device when said smart card is installed in said host device.

16. (currently amended) A system for providing power to processing and memory circuitry of a smart card said method comprising:

 primary non-rechargeable power means for providing power to said processing and memory circuitry, said primary means being disposed in said smart card; and

 secondary rechargeable power means, also disposed in said smart card, wherein said secondary power means are charged when said smart card is installed in a host device with power from said host device.

As has been demonstrated, neither Amano, nor the combination of Amano and Vega, teach or suggest the “recharging circuitry” of claim 1. Consequently, neither Amano, nor the combination of Amano and Vega can teach or suggest the “charging” step of claim 8 or the “secondary rechargeable power means” of claim 16 that are “charged when said smart card is installed in a host device with power from said host device.”

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, because Amano and

Vega fail to teach or suggest recharging a secondary battery on a smart card with power from a host device, the rejection of claims 2-3, 8-12 and 15-19 based on the combined teachings of Amano and Vega should be reconsidered and withdrawn.

Claims 5, 6, 13 and 14 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Amano and Yamaguchi. This rejection is traversed for essentially the same reasons given above with regard to the rejection of claim 1.

Claims 5 and 6 depend from claim 1. As demonstrated above, Amano fails to teach or suggest the “recharging circuitry” of claim 1. Claims 13 and 14 depend from claim 8. As demonstrated above, Amano fails to teach or suggest the “recharging” step of claim 8 in which a “secondary rechargeable battery [is recharged] with power from said host device when said smart card is installed in said host device.”

Yamaguchi likewise fails to teach or suggest such recharging circuitry or a recharging method step where two batteries are provided in a smart card and at least one is charged with power drawn from a host device. In fact, the teachings of Yamaguchi are very similar to Amano in this regard. Yamaguchi teaches “the parasitic diode of the off-state FET 710 prevents the built-in battery 704 from being charged with the voltage of the external power source 701.” (Col. 2, lines 23-25). Appropriately, the recent Office Action does not allege that Yamaguchi contains any such teaching.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, because Amano and Yamaguchi fail to teach or suggest recharging a secondary battery on a smart card with power from a host device, the rejection of claims 5, 6, 13 and 14 based on the combined teachings of Amano and Yamaguchi should be reconsidered and withdrawn.

The newly added claims, claims 20-31, are also thought to be clearly patentable over the prior art of record for reasons similar to those given above with regard to claims 1, 8 and 16. Accordingly, examination and allowance of claims 20-31 is respectfully requested.

80113-0230

09/997,122

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper, which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013/80113-0230 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

DATE: 11 April 2003

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)